UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,525	07/23/2003	Shunichiro Nonaka	0649-0903P	6670

2292   7590   12/14/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
MILIA, MARK R

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
12/14/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

PTOL-90A (Rev. 04/07)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/624,525</td><td>Applicant(s)
NONAKA, SHUNICHIRO</td></tr>
<tr><td>Examiner
Mark R. Milia</td><td>Art Unit
2625</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 September 2007</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9,12,15 and 18</u> is/are rejected.

7)☒ Claim(s) <u>10,11,13,14,16 and 17</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 9/13/07 and has been entered and made of record. Currently, claims 1-18 are pending.

Claim Rejections - 35 USC § 101

2.   Applicant's amendment to claims 7-9 has overcome the rejection set forth in the previous Office Action. Therefore the rejection has been withdrawn.

Response to Arguments

3.   Applicant's arguments filed 9/13/07 have been fully considered but they are not persuasive.

Applicant asserts that DeSalvo (US 2003/0208546) fails to disclose "a type discriminating unit that discriminates, based on a header of the E-mail, the type of the transmitting terminal. The examiner respectfully disagrees as DeSalvo does disclose such a feature. Particularly, DeSalvo states that an analysis module searches the e-mail message for an attachment header to determine if, and what type of attachment, is attached to the e-mail message. Once the file type is identified the attachment

conversion module checks to see if a known mechanism exists for converting the type

of attachment into a format which the wireless device can process. Thus, the type of

application used to create the attached file is identified and in conjunction with the

service **100** maintaining an intimate knowledge of the capabilities/configuration of each

data processing device **110**, the type of transmitting terminal is also known by the

attachment module (see paragraphs 19, 24, 26, 28, and 30).

Therefore, the rejection of claims 1-9, as set forth in the previous Office Action, is

maintained and repeated in this Office Action. Claims 10-18 will be addressed below.

Claim Rejections - 35 USC § 102

4.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

5.   Claims 1-9, 12, 15, and 18 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Patent Application Publication No. 2003/0208546 to DeSalvo et al.

Regarding claim 1, DeSalvo discloses an image-attached mail transiting

apparatus for performing predetermined image processing for an image according to a

type of a transmitting terminal with a camera, which transmits an E-mail to which the

image is attached, comprising: a type discriminating unit that discriminates, based on a

header of the E-mail, the type of the transmitting terminal, which transmits the E-mail to

be received by the image-attached mail transiting apparatus (see Figs. 1 and 2 and

paragraphs 19, 24, 26, 28, and 30), a parameter deciding unit that decides a first

parameter indicating what processing should be performed for the attached image of the E-mail according to the type of the transmitting terminal (see Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34, reference states that attachment processing module **240** processes e-mail attachments transmitted *to* and *from* the wireless device **110**, which shows wireless device **110** can be a transmitting device or a receiving device), and an image processing unit that performs predetermined image processing based on the first parameter for the attached image (see Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34), wherein an image processed by the image processing unit is substituted for the attached image of the E-mail, and then an altered E-mail, to which the substituted image is attached, is transmitted to a receiving terminal (see paragraphs 24, 26, 28, 30, 32, and 34).

Regarding claims 4 and 7, DeSalvo discloses an image-attached mail transiting method and program for performing predetermined image processing for an image according to a type of a transmitting terminal with a camera, which transmits an E-mail to which the image is attached, comprising: a first type discriminating step of discriminating, based on a header of the E-mail, the type of the transmitting terminal, which transmits the E-mail (see Figs. 1 and 2 and paragraphs 19, 24, 26, 28, and 30), a first parameter deciding step of deciding a first parameter indicating what processing should be performed for an attached image of the E-mail according to the type of the transmitting terminal (see Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34, reference states that attachment processing module **240** processes e-mail attachments transmitted *to* and *from* the wireless device **110**, which shows wireless device **110** can

be a transmitting device or a receiving device), a first image processing step of

performing predetermined image processing based on the first parameter for the

attached image; an image substituting step of substituting an image processed in the

first image processing step for the attached image of the E-mail (see paragraphs 24, 26,

28, 30, 32, and 34), and a mail transmitting step of transmitting an altered E-mail, to

which a substituted image is attached, to a receiving terminal (see paragraphs 24, 26,

28, 30, 32, and 34).

Regarding claim 2, DeSalvo further discloses wherein the type discriminating unit

discriminates, based on the header of the E-mail, the type of the receiving terminal

having a display (see Fig. 2 and paragraphs 19, 24, 26, 28, and 30), the parameter

deciding unit decides a second parameter indicating what processing should be

performed for the attached image of the E-mail according to the type of the receiving

terminal (see paragraphs 17, 19, 24, 28, and 30), and the image processing unit

performs predetermined image processing based on the second parameter for the

attached image (see paragraphs 17, 19, 24, 28, and 30).

Regarding claims 3, 6, and 9, DeSalvo further discloses wherein the type

discriminating unit discriminates, based on the header of the E-mail, the type of the

receiving terminal having a display (see Fig. 2 and paragraphs 19, 24, 26, 28, and 30),

the parameter deciding unit decides a third parameter indicating what processing should

be performed for the attached image of the E-mail according to the type of the

transmitting terminal and the type of the receiving terminal (see paragraphs 17, 19, 24,

28, and 30), and the image processing unit performs predetermined image processing

based on the parameter for the attached image (see paragraphs 17, 19, 24, 28, and

30).

Regarding claims 5 and 8, DeSalvo further discloses a second type

discriminating step of discriminating, based on the header of the E-mail, a type of the

receiving terminal having a display (see Fig. 2 and paragraphs 19, 24, 26, 28, and 30),

a second parameter deciding step of deciding a second parameter indicating what

processing should be performed for the attached image of the E-mail according to the

type of the receiving terminal (see paragraphs 17, 19, 24, 28, and 30), and a second

image processing step of performing predetermined image processing based on the

second parameter for the attached image (see paragraphs 17, 19, 24, 28, and 30),

wherein the image substituting step substitutes an image processed in the first image

processing step and the second image processing step for the attached image of the E-

mail (see paragraphs 24, 26, 28, 30, 32, and 34).

Regarding claims 12, 15, and 18, DeSalvo discloses an image-attached mail

transiting apparatus and method for performing predetermined image processing for a

first image according to a type of a transmitting terminal with a camera, which transmits

a first E-mail to which the first image is attached, comprising: a type discriminating unit

that discriminates, based on a header of the first E-mail, the type of the transmitting

terminal which transmits the first E-mail to be received by the image-attached mail

transiting apparatus (see Figs. 1 and 2 and paragraphs 19, 24, 26, 28, and 30), a

parameter deciding unit that decides a parameter indicating what processing should be

performed for the attached image, according to the type of the transmitting terminal (see

Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34, reference states that

attachment processing module **240** processes e-mail attachments transmitted *to* and

from the wireless device **110**, which shows wireless device **110** can be a transmitting

device or a receiving device), an image processing unit that performs predetermined

image processing for the attached image, based on the parameter (see Figs. 1 and 2

and paragraphs 17, 19, 24, 28, 30, and 34), an image storing unit that stores the

attached image processed by the image processing unit (see paragraphs 21-22), and a

mail transmitting unit that transmits a second E-mail to a receiving terminal, the second

E-mail containing an address indicating where the image processed by the image

processing unit is stored (see paragraphs 24, 26, 28, 30, 32, and 34).

Allowable Subject Matter

6.   Claims 10-11, 13-14, and 16-17 are objected to as being dependent upon a

rejected base claim, but would be allowable if rewritten in independent form including all

of the limitations of the base claim and any intervening claims.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Haskins can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.
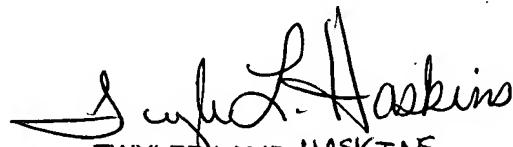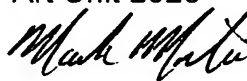
Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia
Examiner
Art Unit 2625

MRM

TWYLER LAMB HASKINS
SUPERVISORY PATENT EXAMINER